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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,975	01/22/2004	Brian J. Cox	388700-058B	7891

37374 7590 09/09/2010  
INSKEEP INTELLECTUAL PROPERTY GROUP, INC  
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EXAMINER
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SEVERSON, RYAN J

ART UNIT	PAPER NUMBER
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3731

NOTIFICATION DATE	DELIVERY MODE
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09/09/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BRIAN J. COX

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Appeal 2009-008375  
Application 10/763,975  
Technology Center 3700

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Before LINDA E. HORNER, WILLIAM F. PATE III, and  
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 (2006) from a final rejection of claims 23-28, 40 and 41. We have jurisdiction under 35 U.S.C. § 6(b) (2006).

The claims are directed to an aneurysm treatment device. Claim 23, reproduced below, is illustrative of the claimed subject matter:

23. A device for treating a vascular aneurysm comprising:

a support structure sized for placement at a region of said vascular aneurysm;

said support structure having a bridge portion spanning at least a neck region of said vascular aneurysm;

said support structure having an open, non-tubular arced configuration;

said bridge portion including a reactive material, said reactive material being expanded when in a reacted state such that said reactive material restricts flow of blood to said vascular aneurysm when said reactive material is in said reacted state.

## REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Silvestrini	5,234,456	Aug. 10, 1993
Deem	6,231,597 B1	May 15, 2001

## REJECTIONS

Claims 23-28, 40 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Deem and Silvestrini. Ans. 3.

## OPINION

*The Rejection of Claims 23-28, 40 and 41 as being unpatentable over Deem and Silvestrini is reversed.*

The Examiner found that Deem discloses a basic device for treating a vascular aneurysm according to independent claims 23 and 40. Ans. 3. The Examiner further found that Deem does not disclose that covering 102, read as the claimed “reactive material,” expands in the reacted state. Ans. 4. The Examiner concluded that it would have been obvious to construct Deem’s cover from the hydrophilic material taught by Silvestrini in order to help occlude the neck of the aneurysm. *Id.*

Appellant contends that it was unreasonable for the Examiner to interpret Deem’s cover 102 as the claimed “reactive material” because it is constructed from expanded polytetrafluoroethylene (PTFE) or polyester mesh—relatively inert substances, and is not “expanded when in a reacted state.” Reply Br. 7-9; Deem col. 5, ll. 49-50. Appellant further contends that there is no rational basis for the Examiner’s proposed combination because Silvestrini does not teach or fairly suggest using the disclosed hydrophilic material for occlusion. App. Br. 5-9. Appellant’s arguments are persuasive.

Construing the claim is the first step in an obviousness analysis. *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 714 (Fed. Cir. 1998) (citations omitted). Pending claims are given their broadest reasonable construction consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

The Federal Circuit has stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be

some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). It is improper to base a conclusion of obviousness upon facts gleaned only through hindsight. “To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996) (citing *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)).

Despite performing the claimed function of “restrict[ing the] flow of blood to said vascular aneurysm,” Deem does not describe any particular reaction undergone by the cover 102. It was therefore unreasonable to interpret Deem’s cover as the claimed reactive material. Additionally, Silvestrini’s hydrophilic material absorbs liquid in order to inflate the stent 10 so that it remains in place by impinging on the interior lumen wall. Silvestrini col. 2, ll. 38-58. Silvestrini does not expressly provide any indication, nor would one of ordinary skill in the art recognize, that Silvestrini’s hydrophilic material would be suitable for the Examiner’s proposed use—occlusion. The Examiner’s conclusion is therefore based upon speculation and conjecture. We are constrained to conclude that the Examiner improperly resorted to hindsight gleaned only through Appellant’s Specification in order to reach the conclusion of obviousness. Accordingly, the rejection of independent claims 23 and 40, along with dependent claims 24-28 and 41, as being unpatentable over Deem and Silvestrini must be reversed.

*Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter new grounds of rejection for claims 23-28, 40 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Deem.*

Other than those discussed above, Appellant does not contest any of the Examiner's other findings related to the embodiments of Deem depicted in Figures 4, 11B, and 13 and relied on in rejecting claims 23-28, 40 and 41. *See* Ans. 3-5. Those findings are adopted. As discussed above, while the Examiner erred by interpreting Deem's cover 102 as the claimed "reactive material," the material forming elements 14 at the mid-region 15 (the "bridge portion" or "occlusion region") of Deem's stent 10, 101, which reacts and expands when exposed to heat or electric current, meets this limitation. Deem col. 4, ll. 57-64, col. 5, ll. 22-35, 47-49. By virtue of decreasing the cross-sectional area through which blood can flow to the aneurysm, the "reactive material" of claim 23 or the entire "occlusion region" of claim 40, "restricts" or "substantially restricts" the "flow of blood to said vascular aneurysm," respectively. Thus, the Examiner's rejection is modified by interpreting the material forming elements 14 at the mid-region 15 of Deem's stent 101 as the claimed "reactive material" as opposed to the material forming cover 102. The Examiner's rejection is further modified by discarding the Examiner's finding that Deem does not disclose a reactive material that is "expanded when in a reacted state." Ans. 5. Accordingly, there is no need to rely upon any teachings of Silvestrini in order to conclude that the subject matter of claims 23-28, 40 and 41 would have been obvious to one having ordinary skill in the art. Since we have modified the Examiner's rejection in this manner, we denominate this rejection a "new

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grounds” of rejection under 37 C.F.R. § 41.50(b) in order to provide Appellant a full and fair opportunity to respond.

### DECISION

For the above reasons, the Examiner’s rejection of claims 23-28, 40 and 41 as being unpatentable over Deem and Silvestrini is reversed. We enter new grounds of rejection of claims 23-28, 40 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Deem.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2008). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .
- (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED; 37 C.F.R. § 41.50(b)

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